REMARKS

In response to the Office Action, Applicant respectfully requests the Examiner to reconsider the above-captioned application in view of the following comments.

Discussion of Rejection of Claims 1-5, 8, 14-16, 19-22, and 23-40 Under 35 U.S.C. § 103(a)

In an Office Action, Claims 1-5, 8, 14-16, 19-22, and 23-40 were rejected were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,167,567, to Chiles, et al. (hereinafter "Chiles") in view of U.S. Patent No. 6,080,207, to Kroening, et al (hereinafter "Kroening"). For the reasons set forth below, Applicant respectfully disagrees with the Examiner's rejections.

To establish a *prima facie* case of obviousness a three-prong test must be met. First, there must be some suggestion or motivation, either in the references or in the knowledge generally available among those of ordinary skill in the art, to modify the reference. Second, there must be a reasonable expectation of success found in the prior art. Third, the prior art reference must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488 (Fed. Cir. 1991). Applicant respectfully submits that the cited prior art fails to teach or suggest all of the claim limitations from the above-listed claims. Furthermore, Applicant respectfully submits that there is no motivation to modify the prior art as suggested by the Examiner.

Claim 1, 14, 19, 22, 25, and 33

One embodiment of the claimed invention is directed to performing maintenance and diagnostic actions. In particular, Claim 1 recites "a graphical user interface comprising a presentation of a text markup language document and providing control for maintenance and diagnostics of the electronic device to an end user wherein the graphical representation includes at least one user interactive control for activating a hypertext link." In one embodiment, the activated hypertext link is processed locally in the electronic device to, for example, determine whether the link satisfies predetermined criteria such as criteria identifying the activated link with generating a disk image responsive to the activated link. Thus, Claim 1, as amended, further recites "determining in the electronic device whether the activated hypertext link satisfies predetermined criteria; and generating a disk image responsive to receiving the activated hypertext link" (emphasis added). Independent Claims 14, 19, 22, 25, and 33 each recite similar

limitations. As discussed below, Applicant submits that the cited references do not teach or suggest, at least, these limitations.

Chiles is generally directed to a technique for automatically updating software on a client computer in a networked client-server computer. In Chiles, each software package registers itself during the installation on the computer. *See* col. 4, lines 7-15. As part of registration, a network uniform resource locator (URL) is provided of an FTP server at which an update script for that is associated with the software package. *See* col. 4, lines 13-15. At a user-scheduled time, the client-update software on the computer establishes a network connection to the FTP site and downloads the corresponding script. *See* col. 4, lines 32-42. At the computer, the downloaded script is executed and/or control is passed to a website. *See* col. 4, lines 43-65.

Applicant respectfully submits that Chiles fails to teach or suggest the limitation from Claim 1, as amended: "a graphical user interface comprising a presentation of a text markup language document and providing control for maintenance and diagnostics of the electronic device to an end user." Similar limitations are recited in independent Claims 14, 19, 22, 25, and 33. In the Office Action, the Examiner took the position that these limitations were described on col. 3, line 57 – col. 4, line 15 of Chiles. Applicant has reviewed the cited section and submits that the cited section fails to describe this limitation. The cited section merely describes the auto-update procedure described above but fails to describe a graphical representation of a text markup language document providing control for maintenance and diagnostics of the electronic device to an end user wherein the graphical representation includes at least one interactive control for activating a hypertext link. Applicant notes that although the client update software of Chiles provides certain graphical user interfaces, e.g., Figures 14A-14D, there is no teaching or suggestion that these GUI are graphical representations of a text markup language providing control for maintenance and diagnostics of the electronic device to the end user such as generating a disk image.

Moreover, as the Examiner indicated, Chiles discloses a client-server update mechanism. However, nowhere does Chiles disclose "determining in the electronic device whether the activated hypertext link satisfies predetermined criteria" (emphasis added) as recited in Claim 1. Similar limitations are recited in independent Claims 14, 19, 22, 25, and 33. For example, in one embodiment of the claimed invention, the electronic device determines whether the activated hypertext link satisfies predetermined criteria so that the activated link can be handled in a specific way. *See* Specification, page 9, first full paragraph. In one such embodiment,

predefined criteria may identify generating a disk image as the specific way of handling an activated hypertext link. *See* Figure 5. Thus, Applicant submits that Chiles also fails to teach or suggest this element of each of Claims 14, 19, 22, 25, and 33.

Moreover, Applicant also submits that Kroening fails to cure the deficiencies of Chiles set forth above. In particular, Kroening fails to disclosure a method of performing diagnostic and maintenance actions. Rather, Kroening discloses an automated tool for configuring software in a factory via disk images in a factory. Kroening fails to disclose a method of performing interactive diagnostic and maintenance comprising "receiving an activated hypertext link from the end user" and "generating a disk image responsive to receiving the activated hypertext link." Applicant therefore submits that neither Kroening nor Chiles, alone or in combination, teach or suggest all limitations of independent Claims 1, 14, 19, 22, 25, and 33.

Furthermore, Applicant respectfully submits that there is no motivation or suggestion to combine Chiles with Kroening as suggested by the Examiner. In the Office Action, the Examiner took the position that "It would have been obvious at the time of the invention that a person with ordinary skill in the art would want to create the disk image of Kroening in the updating software interface of Chiles for an easy to monitor software configuration process." Applicant respectfully submits that this finding fails to support a valid reason for modification of the cited references to derive the claimed invention. Applicant respectfully submits that the Examiner has failed to explain how creating a disk image would (1) facilitate monitoring the software configuration process or (2) why additional monitoring of the software configuration in Chiles is needed.

In particular, Applicant submits that the prior art must suggest the desirability of the claimed invention. *See* M.P.E.P. § 2143.01. The fact that references can be modified is not sufficient to establish prima facie obviousness. *Id.* Furthermore, the fact that the claimed invention is within the capability of one of ordinary skill in the art is not sufficient by itself to establish prima facie obviousness. *Id.* The Examiner may not "pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art." *In re Wesslau*, 147 U.S.P.Q. 391, 393 (CCPA 1965).

In explaining the Examiner's basis for finding a motivation to combine on page 4 of the Office Action, the Examiner first argues that the generation of a software configuration in Kroening is similar to updating software in Chiles. The Examiner next argues that

> Kroening uses Microsoft Windows Operating System as based (sic) to run all the applications including the image builder 20 (col. 5 line 63 – col. 6 line 22), which the image is passed from the storage device to an image server via an interface (col. 6, lines 34-38), and it is also well known in that art that hard drive, a floppy disk, a recordable CD, or a zip drive (col. 6 lines 45-50) will be displayed on the interface if using the Microsoft Windows; therefore "It would have been obvious at the time of the invention that a person with ordinary skill in the art would want to create the disk image of Kroening in the updating software interface of Chiles for an easy to monitor software configuration process." Office Action, at 4 (emphasis in original).

Applicant submits that usage of a graphical icon that includes an image of disk in a graphical user interface is different from usage of a disk image, e.g., a copy of data on a disk. For example, Kroening discloses using a disk image of software applications to configure the contents of a disk of a new computer during manufacturing. Applicant therefore submits that a motivation to combine that includes graphical icon of a disk is inapposite to the claims of the present application. Thus, Applicant submits that the Examiner has failed to identify a motivation to combine Chiles with Kroening.

Furthermore, Applicant submits that "an interface" as described in the cited portions of Kroening refers to an interface for sending bill of material data from a minicomputer to an image builder. *Kroening*, col. 6, lines 41-45. Thus, the portion of Kroening cited by the Examiner does not teach or suggest "a graphical user interface" as recited in Claim 1, as amended. Applicant thus submits that this portion of the Examiner's purported motivation to combine is inapposite to finding a motivation to combine Chiles with Kroening.

Applicant thus submits that the Examiner has failed to establish a motivation to combine, either in the prior art, or as within the ordinary skill in the art. Rather, Applicant submits that the Examiner has merely made conclusory findings regarding the motivation to modify the cited references based on picking and choosing parts of the cited references to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art. Applicant therefore requests the Examiner to withdraw his rejection of Claims 1, 14, 19, 22, and 25.

Claims 2-5, 8, 15, 16, 20, 21, 23, 24, 26-32, and 38-40

For at least the reasons set forth above, Applicant submits that Claims 1, 14, 19, 22, 25, and 33 are allowable. Since Claims 2-5, 8, 15, 16, 20, 21, 23, 24, 26-32, and 38-40 each depend

on one of Claims 1, 14, 19, 22, 25, and 33, Applicant respectfully submits that these claims are allowable for the reasons discussed above and the subject matter of their own limitations.

Conclusion

Applicant has endeavored to address all of the Examiner's concerns as expressed in the outstanding Office Action. Accordingly, amendments to the claims for patentability purposes, the reasons therefore, and arguments in support of the patentability of the pending claim set are presented above. Applicant submits that the claim limitations discussed above represent only illustrative distinctions. Hence, there may be other patentable features that distinguish the claimed invention from the prior art. Any claim amendments which are not specifically discussed in the above remarks are not made for patentability purposes, and the claims would satisfy the statutory requirements for patentability without the entry of such amendments. In addition, such amendments do not narrow the scope of the claims. Rather, these amendments have only been made to increase claim readability, to improve grammar, and to reduce the time and effort required of those in the art to clearly understand the scope of the claim language.

In light of the above amendments and remarks, reconsideration and withdrawal of the outstanding rejections is specifically requested. If the Examiner has any questions which may be answered by telephone, he is invited to call the undersigned directly. Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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